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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,940	08/28/2003	Steven L. Carey	WR-616	1939
33464	7590	10/14/2004	EXAMINER	
WHITE RODGERS DIV. EMERSON ELECTRIC CO. 9797 REAVIS RD. ST. LOUIS, MO 63123			VORTMAN, ANATOLY	
			ART UNIT	PAPER NUMBER
			2835	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/604,940

Applicant(s)

CAREY, STEVEN L.

Examiner

Anatoly Vortman

Art Unit

2835

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/28/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim recites that “apparatus provides control...independent of a battery or external power source”, wherein in the specification recited that: “power supplied from the first connector pin through connector 104 and lead 106 to lead 110 to a second connector pin so as to enable operation of a heating system” (p. 7) and “power supplied from a third connector pin through connector 104 and lead 112 to leads 116 and 118 and to a fourth connector pin and fifth connector pin on the sub-base 200 so as to enable the cooling operation of the HVAC system” (p. 9). The aforementioned interconnections are depicted on Fig. 2. The recitations of the claim and of the specification contradict to each other since the aforementioned passages from specification are clearly pointing out that power supplied from the external power source.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-11 and 13, are rejected under 35 U.S.C. 102(b) as being anticipated by US/5,107,918 to McFarlane et al., (McFarlane).

Regarding claim 1, McFarlane disclosed (Fig. 2-6) an apparatus (34) adapted to be connected to a thermostat sub-base assembly (36) in connection with an HVAC system, the apparatus comprising: a connector (50) configured to be releasably connectable to the sub-base assembly (36), and a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connection (Rh) on the sub-base (36) to a second connection (W) on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a predetermined temperature.

Regarding claim 4, McFarlane disclosed (Fig. 2-6) an apparatus (34) adapted to be connected to a thermostat sub-base assembly (36) having a plurality of connector pins (42) in connection with an HVAC system, the apparatus (34) comprising: a connector (50) configured to be releasably connectable to the connector pins (42) on the sub-base assembly (36), and a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connector pin on the sub-base (36) to a second connector pin on the sub-base (36) so as to enable heating operation of the HVAC

system when the switching means (144) is exposed to an ambient temperature below a predetermined temperature.

Regarding claim 7, McFarlane disclosed (Fig. 2-6) an apparatus (34) adapted to be connected to a thermostat sub-base assembly (36) associated with a plurality of terminals for connecting to an HVAC system, the apparatus (34) comprising: a connector (50) configured to be releasably connectable to the connector pins (42) on the sub-base assembly (36), and a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connector pin on the sub-base (36) to a second connector pin on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a non-adjustable predetermined temperature.

Regarding claim 2, 5, 8, and 10, McFarlane disclosed (Fig. 2-6) an apparatus (34) in combination with a thermostat sub-base assembly (36) having a plurality of connector pins (42) associated with a plurality of terminals for connecting to an HVAC system, the apparatus comprising: a connector (50) configured to be releasably connectable to the connector pins (42) on the sub-base assembly (36), a temperature-actuated switching means (140, 144, 146, 154, 156) for mechanically switching power (via mechanical relays (122, 136)) supplied from a first connector pin on the sub-base (36) to a second connector pin on the sub-base (36) so as to enable heating operation of the HVAC system when the switching means (144) is exposed to an ambient temperature below a non-adjustable predetermined temperature; and a housing (38) that covers the connector (50) and connection pins (42) of the sub-base assembly (36) so as to prevent damage or entry of unwanted materials.

Art Unit: 2835

Regarding claims 3, 6, 9, and 11, McFarlane disclosed (Fig. 5, 6) a second temperature actuated switching means (140, 144, 146, 154, 158) for mechanically switching power (via mechanical relays (122, 124, 136), supplied from a third connection (Rc) on the sub-base (36) to a fourth connection (Y) and fifth connection (Y₂) on the sub-base (36) so as to enable cooling operation of HVAC system when the second switching means (140, 144, 146, 154, 158) is exposed to an ambient temperature above a second predetermined temperature.

Regarding claim 13, McFarlane disclosed (Fig. 2, 4) that the sub-base (36) comprises eight connector pins (42) and the connector (50) is a socket connector configured to be releasably connectable to the eight connector pins (42).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

US/Des. 310177, 5485954, 6169937, and 4421271 disclosed thermostats with sub-bases;

US/3007028, 3197594, DE/2241974, JP/10-328037, and GB/2132826 disclosed plug-in thermostats;

US/6252492, 6563088, 5153552, 4314223, 2137569, 4902999, 4485282, and 4704595 disclosed plug-in thermal switches;

US/3110778 and 6315580 disclosed plug-in switches; and,

US/5040097 disclosed plug-in control unit for a motor.

Art Unit: 2835

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 571-272-2047. The examiner can normally be reached on Monday-Friday, between 10:00 am and 6:30 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Lynn Feild can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anatoly Vortman
Primary Examiner
Art Unit 2835

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